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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/751,022	01/02/2004	Eric A. Portman	10022/325	3692

33391 7590 08/11/2006

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EXAMINER

WIN, AUNG T

ART UNIT	PAPER NUMBER
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2617

DATE MAILED: 08/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/751,022

Applicant(s)

PORTMAN ET AL.

Examiner

Aung T. Win

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☒ Claim(s) 25 and 29-33 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

1. Claim 25 is objected to because of the following informalities: The claim appears to be an apparatus claim (system). Nevertheless the claim uses terminology such as "logic". It appears to mean "means". Appropriate correction is required.

Claims 29-33 are objected to because of the following informalities: Claims 29-33 are misnumbered. Examiner considers second Claim 29 to Claim 33 as Claim 31-Claim 35.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 5-9, 17-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

2.1 Claims 5-9 recites the limitation "the request" in the claims respectively. There is insufficient antecedent basis for this limitation in the claim. It is unclear whether "the request" refers to "a request" cited in Line 3 of Claim 1 or "an authorization request" cited in Line 9 of Claim 1.

2.2 Claims 17-20 recites the limitation "the request" in the claims respectively. There is insufficient antecedent basis for this limitation in the claim. It is unclear whether "the request" refers to "a request" cited in Line 3 of Claim 1 or "an authorization request" cited in Line 9 of Claim 1.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-22, 25, 32 & 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Elsey et al. (US 20020055351A1) in view of Woods et al. (US 20020049907A1).

3.1 Regarding Claim 1, Elsey provides an information assistance system and method to a wireless terminal [Abstract] [Paragraph 0004, 0012 & 0049, 0071, 0096 & 0115] to connect the private subscriber terminal without sharing the contact number to the requesting user. The method comprises: Generating and transmitting a request for connecting a private subscriber terminal [Paragraph 0055, 0064, 0065] to an information

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assistance application located on information assistance server (personalized information server; see Figure 1 & Paragraph 0058). Elsey also discloses transmitting an authorization request to the private subscriber terminal to receive connection request authorization from the private subscriber terminal. Therefore, it is obvious to one of ordinary skill in the art that the method teaches determining step (i.e., how to contact the private subscriber terminal) in order to transmit the authorization request to the private subscriber terminal. Elsey further discloses receiving a reply from the private subscriber terminal indicating whether or not to connect with the wireless terminal [Paragraph 0064, 0067, 0068, 0074].

Elsey's system and method is to provide information assistance service by establishing the connection request based on called party authorization. Elsey's system and method does not explicitly disclose providing stored information as claimed (i.e., sharing private information based on replied authorization request) although the system and method teaches that information can be stored as private mode.

Woods discloses sharing stored private information of the authority based on authorization replied by the authority [See summary; Paragraph 0032] [Also see Figures]. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention of made modify the Elsey's system as taught by Woods to share stored private information as claimed. One of ordinary skill in the art at the time of invention of made to do this to provide improved directory assistance system for both wireless and conventional telephone users by sharing information effectively while

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protecting the privacy of the user and the security of the data [Woods: Paragraph 0009-0010].

3.2 Claims 13 and 25 are rejected for the same reason as stated above in Claim 1 rejection because claimed means substantially read on the corresponding method of Claim 1. At the time of invention of made, it is obvious to one of ordinary skill in the art that modified system and method teaches the claimed code segments or the logic in order to execute the claimed steps accordingly.

3.3 Claim 35 is rejected for the same reason as stated above in Claim 1 rejection because claimed means substantially read on the corresponding method of Claim 33.

3.4 Regarding Claims 2, 3, 14, 15, 26 & 27, modified system and method teaches generating step for providing authorized private information of the subscriber terminal [See Claim 1 rejection].

3.5 Regarding Claims 4, 8, 12, 16, 19, 28, 31, modified system teaches response comprising telephone, SMS, email, facsimile etc. [Elsay: Abstract & Paragraph 0012, 0096]. Official notice is taken that the concept and feature of multi-modal messaging capability is well-known to one of ordinary skill in the art at the time of invention of made.

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3.6 Regarding Claims 5, modified system teaches claimed request because the modified system is the directory assistance information providing system [also See Figures of Elsey & Woods].

3.7 Regarding Claims 6, 7, 9, 10, 17, 18, 21 & 32, modified system comprises the Voice Response Unit [Elsey: Paragraph 0051 & 0053] therefore the modified system teaches the claimed voice recognition module. At the time of invention of made, it is obvious to one of ordinary skill in the art that information assistance system comprises voice recognition module based on speaker dependent and speaker independent technology to provide cost effective system and to achieve higher quality of service. Moreover, Modified system access contact information stored in the database server based on the request as claimed [Elsey: Paragraph 0047, 0054 & Figures] [Also see Woods reference].

3.8 Regarding Claim 11, modified system does not explicitly teach contact preference associated with subscriber terminal. Modified system teaches determining how to contact the requestor based on contact preference [Paragraph 0076, Line 11-13]. It would have been obvious to one of ordinary skill in the art at the time of invention of made to further modify the system to set the contact preference for the requested party as claimed. One of ordinary skill in the Art Unit would have been motivated to do this to provide improved information assistance system that minimizes undesirable alerts on the subscriber terminal.

3.9 Regarding Claims 20 and 22, modified system teaches the identity of the user so that to provide such information to the subscriber terminal for generating authorization request including requester information [See Claim 13 and 1 rejections]. Modified system also teaches Voice Interactive Response system [Paragraph 0051 & 0053]. Therefore, it is obvious to one of ordinary skill in the art at the time of invention of made that, the modified system would have been implemented with claimed voice print module to properly identify the requester for generating authorization request with requester information to the subscriber terminal. Moreover, at the time of invention of made, voice print module are well known to skill in the telephony art for identifying the user based on speaker dependent and speaker independent speech recognition technology.

4. Claims 23, 24, 29, 30, 33 & 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Elsey et al. (US 20020055351A1) in view of Woods et al. (US 20020049907A1), further in view of Strunk et al. (US 20020068551A1).

4.1 Regarding Claims 23, 24, 29, 30, 33 & 34, modified system does not teach saving requested information on the subscriber terminal or wireless terminal.

Strunk discloses directory information assistance system [Background] including storing the requested information in the requesting wireless devices [Paragraph 0022 & 0023] [contact information software: Paragraph 0020].

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Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention of made to further modify the wireless devices as taught in modified system with contact information software as taught by Strunk to store requested information. One of ordinary skill in the art at the time of invention of made to do this to provide improved and efficient storage method for user convenience.

Conclusion

The Art Unit location of your application in the USPTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Art Unit 2617.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aung T. Win whose telephone number is (571) 272-7549. The examiner can normally be reached on 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Duc Nguyen can be reached on (571) 272-7503. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Aung T. Win
Group Art Unit 2617
July 31, 2006


DUC NGUYEN
PRIMARY EXAMINER

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